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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 09/937,722                | 03/28/2002  | Ralf-Peter Franke    | CERA-233            | 7010             |
| 24972                     | 7590        | 06/23/2005           | EXAMINER            |                  |
| FULBRIGHT & JAWORSKI, LLP |             |                      | DAVIS, DANIEL J     |                  |
| 666 FIFTH AVE             |             |                      | ART UNIT            |                  |
| NEW YORK, NY 10103-3198   |             |                      | PAPER NUMBER        |                  |

3731

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/937,722 | <b>Applicant(s)</b><br>FRANKE ET AL. |  |
|                              | <b>Examiner</b><br>D. Jacob Davis    | <b>Art Unit</b><br>3731              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 59-91 is/are pending in the application.
- 4a) Of the above claim(s) 60-62, 65, 68, 69, 72-75, 80-82 and 84-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59, 63, 64, 66, 67, 70, 71, 76-79 and 83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 60-62, 65, 68, 69, 72-75, 80-82 and 84-91 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 28, 2005. (It is noted that although applicant states that claims 73 and 75 are readable on the elected specie, no arguments are presented by applicant that Y-TZP and ZTPA are obvious differences of material. Therefore, the claims are withdrawn by the examiner.)

### ***Double Patenting***

Claim 79 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 78. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 71 and 76-79 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The specification fails to support an instrument or tool *consisting of* a biocompatible bioinert material.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 59, 64, 66, 70, 71, 76, 77 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,531,555 to Tatematsu et al. Tatematsu discloses in figure 1 scissors fully capable of being used in surgery. The scissors having blades consisting of silicon nitride ceramic (column 3, lines 53-57. and column 4, lines 4-11). Examiner interprets the “instrument” and the “tool” as not referring to the entire mechanism, but the effecting end or effecting portion of the device. For example, applicant’s “drill” is actually a drill bit and not an entire drill.

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Claims 59, 63, 66, 67, 71, 76, 77, 78 and 83 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,879,406 to Lilley. Lilley discloses an "instrument/tool" in column 7, lines 54-60 wherein the head of the device may be made of YTZP. The Lilley device may be considered an instrument/tool since the device may be used to perform other functions such as hammering. Furthermore, it may be used as a trial device to determine an appropriate size or location for the prosthetic.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59, 63, 64, 66, 67, 70 and 83 are rejected under 103(a) as being unpatentable over U.S. Patent No. 6,132,427 to Jones et al. in view of U.S. Patent No. 5,688,731 to Chatterjee et al. Jones discloses in figure 2 a surgical instrument, specifically a scalpel. The blade has a stainless steel substrate 12 and a coating 16 (column 3, lines 16-25). The reference further describes ceramic coatings of the same type as applicant's, i.e., aluminum oxide and zirconia-yttria. The reference is silent regarding the exact nature of the zirconia-yttria ceramic. However, Chatterjee teaches in column 2, line 67-column 3, line 2, that Y-TZP is a highly insulating material. Jones describes that the zirconia-yttria coating is used as an insulation. Therefore, it would have been

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would have been obvious to one of ordinary skill in the art at the time the invention was made to make the coating out of Y-TZP since it is a highly insulating zirconia-yttria ceramic material.

*Response to Arguments*

Applicant's arguments filed January 14, 2005 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD

  
GLENN K. DAWSON  
PRIMARY EXAMINER